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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/712,268
Filing Date: November 14, 2003
Appellant(s): TIEU ET AL.

Stephen M. Hertzler
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 01/15/2008 appealing from the Office action mailed 06/14/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US PG Pub 2002/0099544 Levitt et al 07/2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 and 5-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Levitt et al (U.S. PG Pub No. 2002/0099544).

As per claims 1-3 and 5-40, Gilliam et al teach a computer-implemented method for processing plural rights expressions associated with an item for use in a system for controlling use of the item in accordance with the rights expressions, the method comprising: receiving a request to use the item, the item having associated rights expressions governing use of the item; returning one or more rights expressions including on or more conditions that must be satisfied in order to use the item; and processing the returned rights expressions in a manner to facilitate selection of the returned rights expressions in order to use the item in accordance with the selected rights expressions, prioritizing the returned rights expressions based on one or more conditions of the returned rights expressions, so as to facilitate selection of the returned rights expressions. (*see abstract, paragraphs 0011, 0162-0179)).*

(10) Response to Argument

In regard to Applicant's arguments filed on 01/15/2008, Applicant argues that the prior art of record fails to disclose the recited feature:

a. "processing plural rights expressions associated with an item for use in a system for controlling use of the item in accordance with the rights expressions". As indicated above, the cited reference Levitt et al discloses this limitation in paragraph [0011], [0162], [0179], specifically wherein said grammar expressions may be played to a user. As an option, a score may be assigned to each of the grammar expressions, As such, the grammar expressions may be prioritized and conditionally outputted to a user based on the score. Furthermore, any grammar expressions that are representative of invalid addresses are removed. Such resultant list of grammar expressions are compared against a merged n-best list 518. Please note that the grammar expressions of Levitt is readable as a plural right expressions of Applicant's claimed invention.

b. "receiving a request to use an item, the item having associated rights expressions governing use of the item". However, the Examiner respectfully disagrees with Applicant's characterization of the prior art. Levitt discloses this limitation in paragraph [0179], specifically wherein said any of the grammar expressions outputted from operation 506 are compared against the database of addresses. Such comparison is used to prioritize any remaining grammar expressions based on the score set forth hereinabove. Therefore, the process of comparing grammar expressions against addresses as described above is readable as rights expressions governing use of the item of Applicant's claimed invention.

c. Applicant further argues that Levitt fails to disclose: "returning one or more rights expressions including one or more conditions that must be satisfied in order to use the item, and processing the returned rights expressions in a manner to facilitate selection of the returned rights expressions in order to use the item in accordance with the selected rights expressions". As noted above, it is the Examiner believes that Levitt discloses this limitation in 0011], [0162, [0179].

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Pierre Eddy Elisca/
Primary Examiner

Conferees:
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